

Appl. No. 10/687,017
Amendment and Response dated June 14, 2006
Reply to Final Office Action of April 14, 2006

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Final Office Action dated April 14, 2006 in which Claims 2-12, 14-19, 21-32, 34-40 and 42-53 were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,537,945 (hereinafter "*Singleton*"). The Examiner further stated that Claims 17-19 stand withdrawn as non-elected claims in the Application. Applicants thanks the Examiner for the care and diligence with which she has examined the pending claims.

I. Status of the Claims

By this reply, Claims 15 and 44 have been amended and Claims 16 and 46 cancelled as being incorporated into such amended claims. Furthermore, Claims 51 and 52 have been amended to remove structural promoter elements which were not included in the claim from which they depend. Furthermore, withdrawn Claim 17 has been amended to be redirected to Claim 15, since Claim 16 whose limitation is now incorporated into Claim 15 has been canceled. Finally, Claims 54 and 55 are new for additional embodiments to which the Applicants are entitled.

Claims 2-12, 14, 15, 17-19, 21-32, 34-40, 42-45 and 47-55 are currently pending after this Amendment, in which:

- Claim 15 is an independent claim from which Claims 2-12, 14 and 49-54 depend;
- Claim 44 is an independent claim from which Claims 21-32, 34-40, 42, 43, 45, 47-48 and 55 depend; and
- Claims 17-19 stand withdrawn with traverse as non-elected process claims in the Application.

II. Rejection based on § 102(e) over *Singleton*

The Office Action dated April 14, 2005 stated on the Office Action Summary sheet (PTO-326) and on Page 3 of the Detailed Action that Claims 2-12, 14-19, 21-32, 34-40 & 42-53 were rejected. Applicants have assumed in this Response that the inclusion of withdrawn Claims 17-19 to such list of rejected claims by the Examiner was unintentional, since the Examiner reiterated in the conclusion on Page 5 of the Detailed Office Action that such claims stand withdrawn. However, should the Applicants be in error, this present amendment should overcome such rejection of Claims 17-19, since Applicants contend that such amendment places the linking Claim 15 in condition for allowance.

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In the foregoing reply, Applicants have presumed that the claims which are rejected based on 102(e) over *Singleton* are Claims 2-12, 14-16, 21-32, 34-40 & 42-53. Applicants respectfully disagree with such rejection and submit that independent Claims 15 and 44 in their currently-amended form and their respective currently-pending dependent claims are not anticipated by *Singleton*.

By this reply, Applicants amended independent Claims 15 and 44 to narrow the composition of the structural promoter by removing Ti and Co from the Markush group. Furthermore, Claims 51 and 52 both dependent from Claim 15 were also amended to remove the Ti and Co elements which were not included in the claim from which they depend. These removed elements were mentioned as components of the catalyst composition of *Singleton*, even though not necessarily for the same intended use as that of the Applicants. Each of the catalysts of Claims 15 and 44 thus now requires a catalytic metal and a hydrothermally-stable structurally-promoted refractory-oxide support, in which the structural promoter comprises an element selected from a list of elements which does not include Co, Ti, La and Ba.

Moreover, Claims 15 and 44 were amended to narrow the catalyst composition by specifying a weight content of such element in the support by the following recitation: "catalyst support which contains from about 1 percent to about 20 percent by weight of the structural promoter based on the final weight of the catalyst support". Such amendment is supported by the application as filed, for example by at least paragraph [0031] of the specification as originally filed.

Applicants contend that *Singleton* does not disclose the elements listed in the Markush Group in the catalyst composition with such range of weight contents in the catalyst support as recited in currently-amended Claims 15 and 44. Thus, not all of the recited elements of the catalysts of Claims 15 and 44 are taught or suggested by *Singleton*, and as such, *Singleton* does not anticipate currently-amended Claims 15 and 44.

The Examiner states on Page 4 of the detailed Office Action dated April 14, 2006 that the removal of La and Ba from such claims did not exclude them from the claimed catalyst composition; but Applicants believe that the Examiner failed to view these claims as a whole, as each limitation of the claims must be considered when determining the patentability of the claims. Although it is true that the open-ended transition phrase 'comprising' does not exclude additional, unrecited elements (such as La, Ba), such claims still requires that the catalyst support contains one element from the Markush group and a specific weight content range of such element not disclosed by *Singleton*, and

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argument, a prior art disclosing a catalyst containing elements 'A', 'B', and 'C' does not read on a claim for a catalyst comprising element 'A', 'B' and another element 'D' selected from a list which does not include element 'C'. Even though the 'C' element could be present as a fourth element in the claimed composition as an unrecited element due to the open-ended terminology, the claimed composition still requires a combination of elements ('A'+ 'B'+ 'D') which is not taught by the prior art.

Furthermore, to address the Examiner's concern, independent Claims 15 and 44 were amended to narrow the composition of the catalytic metal ("said catalytic metal comprising cobalt, nickel, ruthenium, iron or combinations thereof") and the refractory oxide ("wherein the refractory oxide is selected from the group consisting of zirconia, magnesia, titania, alumina, silica, and combinations thereof"). The added Markush group for the catalytic metal is supported by at least originally-filed Claim 16 (which is now cancelled since it is incorporated into Claim 15) and originally-filed Claim 46 (which is now cancelled since it is incorporated into Claim 44). The added Markush group for the refractory oxide is supported by at least paragraphs [0018] and [0027] of the specification as filed. Thus, the three separate required elements in Applicants' claimed catalysts of Claims 15 and 44 do not include the stabilizing elements La and Ba disclosed by *Singleton*. In this way, even though the open-ended terminology used in such claims does not preclude Ba and/or La to be present as an optional fourth unrecited component of the catalyst composition in Claims 15 and 44, the claimed compositions would still require the combination of the three separate elements, which is not taught by *Singleton*.

In summary, in view of all the recitations in each of the independent Claims 15 and 44 that are neither taught nor suggested by *Singleton*, Applicants submit that *Singleton* does not anticipate Claims 15 and 44 and *a fortiori* their respective pending dependent claims 2-12, 14, 17-19, 21-32, 34-40, 42-45 and 47-53. For at least the reasons stated above, Applicants respectfully traverse the rejection and request the Examiner to withdraw the § 102(e) rejection on Claims 2-12, 14, 15, 17-19, 21-32, 34-40, 42-45 and 47-53 and to allow them.

III. New dependent Claims 54 and 55 are allowable over *Singleton*

Applicants further added Claims 54 and 55 to add embodiments to which the Applicants are entitled. New Claim 54 is dependent from Claim 15, and narrows the composition of the structural promoter by further removing some elements from the Markush group of Claim 15. Similarly, new Claim 55 is dependent from Claim 44, and narrows the composition of the structural promoter by

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further removing some elements from the Markush group of Claim 44.

Applicants submit that no new matter was added by way of new claims and that the cancellation of a total number of two claims in this Response (i.e., Claims 16 and 46) is sufficient to cover these two new claims. Applicants respectfully request these new claims to be considered with the elected invention. Applicants believe that independent Claim 15 and 44 as currently-amended are in allowable form, and since each of new Claims 54 and 55 ultimately carries all the limitation of the claim from which it depends, Claims 54 and 55 are *a fortiori* allowable as well.

Applicants respectfully request the allowance of these new Claims 54 and 55.

IV. Rejoinder of withdrawn Claims 17-19 based on MPEP §821.04 due to the allowability of linking Claim 15.

Withdrawn Claims 17-19 covered a process using the catalyst of Claim 16, which is now canceled as being incorporated into Claim 15. Applicants thus amended withdrawn Claim 17 for the use of the catalyst of linking Claim 15, which Applicants believe is now allowable in its currently-amended form. Based on MPEP § 821.04, Applicants respectfully request the rejoinder of the withdrawn process claims 17-19 for their examination in the present Application. Since Applicants believe that withdrawn Claims 17-19 are free from 35 U.S.C. §101 or §112, first paragraph issues, and thus are patentable over the art of record, Applicants further respectfully request the allowance of Claims 17-19.

V. Conclusion

Applicants believe that they have responded to the Final Office Action dated April 14, 2006, and that no new matter is introduced by way of this claim amendment. Entry of the amendments is respectfully requested, as Applicants believe that the foregoing claim amendment requires only a cursory review by the Examiner, does not require a new search or raises any other new issue, and that this amendment places the application in condition for allowance.

Furthermore, based on MPEP §821.04, Applicants respectfully request the rejoinder and allowance of withdrawn non-elected process Claim 17 and its dependent process Claims 18 and 19, as they carry with them all of the limitations of allowable linking catalyst Claim 15.

Favorable action at the Examiner's earliest convenience is respectfully solicited.

In this Response, Applicant may have at times referred to claim limitations in shorthand

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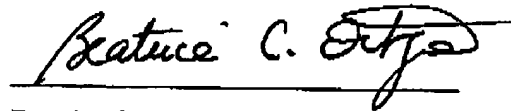
fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations in the presented claims can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims.

If any additional extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefor, and please appropriately charge any fee to Deposit Account Number 16-1575 of ConocoPhillips Company, Houston, Texas. If any other fee is due as a result of the filing of this paper, please charge such fee to the above-mentioned Deposit Account.

Should there be any remaining issue which the Examiner believes would possibly be resolved by a conversation, the Examiner is invited to call the undersigned at (281) 293-4751 so that further delay in a Notice of Allowance can be avoided. Additionally, Applicants would greatly appreciate any suggestion the Examiner may have to move the present case toward allowance.

Also, if the Examiner is not persuaded that the Application is in condition for allowance and further is not believing that whatever issues remaining can be resolved by a telephone interview before issuing an Advisory Action, the Examiner is requested to at least approve entry of the amendments as they will clearly put this Application in better form for appeal by reducing issues for appeal.

Respectfully submitted,



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